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S&H Form: (2/01)

Docket No.: 1454.1101

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Heinz-Jürgen NIGGL

Serial No. 09/937,771

Group Art Unit: 3637

Confirmation No. 7093

Filed: December 10, 2001

Examiner: ANDERSON, GERALD A

For: MECHANICAL LINK BETWEEN SIDE WALLS AND REAR WALL OF A SHEET
CASING (As Amended)

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APPELLANT'S BRIEF UNDER 37 C.F.R. §1.192

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

In a Notice of Appeal filed January 13, 2004, the applicants appealed the Examiner's November 17, 2003 Office Action finally rejecting claims 1-4. Therefore, Appellant's Brief is due March 14, 2004. Appellant's Brief together with the requisite fee set forth in 37 CFR 1.17 is submitted herewith.

I. REAL PARTY IN INTEREST (37 C.F.R. § 1.192(c)(1))

The real part in interest is Siemens AG, the assignee of the subject application.

II. RELATED APPEALS AND INTERFERENCES (37 C.F.R. § 1.192(c)(2))

The appellant, the appellant's legal representative, and the assignee are not aware of any other appeals or interferences which will directly affect or be directly affected by, or have a bearing on, the Board's decision in the pending appeal.

III. STATUS OF CLAIMS (37 C.F.R. § 1.192(c)(3))

Appealed claims 1-4 have been rejected. These are the only pending claims in the subject application.

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IV. STATUS OF AMENDMENTS (37 C.F.R. § 1.192(c)(4))

This Appellant's Brief is accompanied by an Amendment After Appeal. The Amendment After Appeal changes the term "material" to --sheet-metal-- in claim 4. Independent claim 1 previously recited "sheet-metal." The Examiner has therefore considered this limitation. By amending claim 4, the arguments relating to "sheet-metal" apply equally to both independent claims 1 and 4. Entry of the Amendment After Appeal is respectfully requested.

V. SUMMARY OF INVENTION (37 C.F.R. § 1.192(c)(5))

The present invention, for example, as claimed in claim 1, is directed to a mechanical connection. The mechanical connection has a sheet-metal casing (application paragraph [0011]) having a base part 1 (Fig. 1), a pair of sidewalls 2 (Fig. 1) and a rear wall 3 (Fig. 1) such that when assembled, each sidewall 2 adjoins one side of the rear wall 3 (Fig. 1). Each sidewall 2 has a top rear corner in a region displaced from the base part 1 and adjacent to where the sidewall 2 adjoins the rear wall 3 when assembled (Fig. 1). The base part 1, the pair of sidewalls 2 and the rear wall 3 are formed of a single sheet-metal part (paragraph [0011], Fig. 1).

A cutout 4 is formed on each of the sidewalls 2 in the region of the top rear corner (paragraph [0010] and Fig. 1). An angled section 5 is formed on the rear wall 3 (paragraph [0011] and Figs. 2-5).

Hook-like extensions 6 are provided at sides of the angled section 5. Paragraph [0011] and Figs. 2-5. The hook-like extensions 6 snap into the cutouts 4 of the sidewalls 2 when the rear wall 3 is swung into position (paragraph [0012] and Figs. 3-5).

VI. ISSUES (37 C.F.R. § 1.192(c)(6))

The only outstanding issue is whether claims 1-4 patentable distinguish over U.S. Patent No. 5,316,165 to Moran, Jr.

VII. GROUPING OF CLAIMS (37 C.F.R. § 1.192(c)(7))

Although each of the claims defines a separate patentable feature, the claims stand or fall together for the purposes of this appeal.

VIII. ARGUMENT (37 C.F.R. § 1.192(c)(8))

A. U.S. Patent No. 5,316,165 to Moran, Jr.

Moran, Jr. is directed to a plastic enclosure. More specifically, Moran, Jr. is directed to a foldable electronic component enclosure made of plastic sheeting, preferably PVC plastic sheeting. The plastic sheeting is cut and groove to form a foldable plastic blank. Referring to column 2, lines 30-46, the foldable plastic blank has

a backplate, four sidewalls with an edge of each sidewall attached to an edge of the backplate via an integral fold line or hinge, and flanges with an edge of each flange attached via an integral fold line to an edge of a sidewall which is opposite to the edge of the sidewall attached to the backplate. The sidewalls and flanges are foldable along the fold lines to form a six-sided structure. At each end of each flange is a projection or a slot which respectively engages an interlocking slot or projection on the end of an adjacent flange when in the folded position. The enclosure is completed, after the walls and flanges are folded and the interlocking means at the ends of the flanges have been engaged, by affixing a plastic faceplate to the flanges or otherwise closing the open or accessible face with a faceplate.

B. Claims 1-4 Patentably distinguish over U.S. Patent No. 5,316,165 to Moran, Jr.

Moran, Jr. is directed to a foldable plastic electrical enclosure which can be assembled without specially designed machinery and adhesive agents, and which has sufficient mechanical strength for construction related application. See column 2, lines 1-10. Moran, Jr. describes in great detail why the enclosure must be made of plastic instead of metal. Column 1, lines 23-29 describe that sheet-metal electric enclosures are difficult to fabricate onsite, therefore requiring prefabrication and shipment of larger containers (column 1, lines 49-56). Column 1, lines 30-39 describe that prefabricated metal enclosures have a single access panel, which makes it awkward and difficult to work on the electrical components in the enclosure. Column 1, lines 40-47 describe that it is difficult to drill holes in metal enclosures. Therefore, cables must be run through prefabricated knockout holes, again, limiting flexibility. In this manner, it is not necessary to ship pre-assembled enclosures, and shipping space is conserved. See column 1, lines 49-56.

To overcome the drawbacks associated with metal enclosures, Moran, Jr. forms the enclosure from plastic. As described at column 3, lines 5-11 of the reference, it is believed that plastic enclosures are lighter and easier to work with/install compared to sheet-metal enclosure. Moran, Jr. clearly teaches that the enclosure of the reference should not be formed of sheet-metal.

On page 4 of the final Office Action, the Examiner asserts "Moran teaches away from the use of sheet-metal. The selection of a well-known material based on its suitability for the intended use is considered an obvious matter of design choice. Here Moran discloses that

sheet-metal is well-known in the art.” The Examiner’s somewhat unclear conclusion is as follows: “Therefore it would have been obvious at the time of the invention it would have been obvious for one having an ordinary skill in the art to modified Moran using of sheet-metal to form the mechanical connection an obvious matter of design choice.”

Although the Examiner’s conclusion statement is somewhat unclear, it is clear that the Examiner admits Moran, Jr. “teaches away from the use of sheet-metal.” There is no motivation to modify the enclosure of Moran, Jr. to use sheet-metal instead of plastic. In fact, Moran, Jr. teaches that such a modification should not be made. The reference teaches us that if one were to incorporate sheet-metal into the Moran, Jr. device, the essential purpose of the device, i.e., to enclose, would be impossible. See column 1, lines 23-29.

Referring to Manual of Patent Examining Procedure (“MPEP”) § 2141.02, the prior art does not suggest a modification to a primary reference when the primary reference teaches away from the modification. The MPEP provides the example from *W.L. Gore & Associates v. Garlock Inc.* [citation omitted]. In this case, a first reference taught that unsintered PTFE does not respond to conventional plastic processing, and the material should be stretched slowly. A second reference taught rapid stretching for conventional plastics. The Federal Circuit held that the two references together did not suggest rapid stretching of PTFE because the PTFE reference taught away from the modification.

In addition to the claim limitations directed to the enclosure being formed of sheet-metal, the claims also recite that a cutout is formed in each of the sidewalls. On the other hand, the mechanical connection taught in Moran, Jr. is formed from a slot 32 and a projection 30. See column 5, lines 10-15. Therefore, Moran, Jr. does not suggest cutouts in lateral wall.

IX. CONCLUSION

In summary, it is submitted that claims 1-4 patentably distinguish over the prior art.
Reversal of the Examiner's rejection is respectfully requested.

The Examiner is authorized to charge any Appeal Brief Fee or Petition for Extension of Time fee for underpayment or credit any overpayment to Deposit Account No. 19-3935.

Respectfully submitted,

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